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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,712	06/23/2003	Michael Francis Dube	14150-00601	5751

25243 7590 10/24/2005

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WASHINGTON, DC 20007

EXAMINER
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MAYES, DIONNE WALLS

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/600,712	DUBE ET AL.	
	Examiner	Art Unit	
	Dionne Walls Mayes	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,13,15-18,21-30,33,35-37,40,41,44,45 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-10,15-17,21-26,29,30,36,41,44,45,48-57,59 and 60 is/are rejected.
- 7) ☒ Claim(s) 6,13,18,27,28,33,35,37,40,47 and 58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Re-opening of Prosecution/Withdrawal of Previously Indicated Allowable Subject Matter***

After updating the prior art search, the Examiner has determined that a new ground of rejection should be made over the claims, as filed on September 21, 2005, in view of the Berger '306 and Dock references. Therefore, the FINALITY of the rejection of the last Office Action, dated June 28, 2005, and the indication of allowable subject matter has been WITHDRAWN. In view of the discovery of the above-cited art, PROSECUTION IS HEREBY REOPENED as set forth below.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23- 26, 29-30, 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Dock (US. Pat. No. 3,625,228).

Dock discloses all that is recited in the claims since it shows a tobacco rod(!7); a first filter segment (11) connected to the tobacco rod; a cavity (15); a second filter segment (12), and at least one breakable capsule (13) disposed in the cavity. Also included is a longitudinally extending central portion (16) and a longitudinally extending outer portion of the filter material positioned annularly around the central portion (see entire document and figs.)

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, 7-10, 15-17, 21-22, 41, 44-45, 48-57, and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger '306 (US. Pat. No. 3,994,306) in view of Berger '646 (US. Pat. No. 3,599,646) and Dock (US. Pat. No. 3,625,228).

3. Berger '306 discloses, as most clearly evident from Figs. 1 and 6, nearly all that is recited in the claims since it teaches a cigarette comprising a tobacco rod (22); a filter element (24), said filter element incorporating an outer element of filter material (32, 24 or 32b, 34b), and an inner element of filter material (40,42); a cavity (44b) defined by the inner element of filter material (which extends from the proximal end of the filter element) (see Fig. 1); and smoke-modifying material which occupies said cavity (see entire reference, but specifically col. 4, lines 14-36). While Berger '306 may not specifically state that the smoke-modifying material is at least one breakable capsule, Berger '646 (which discloses a cigarette filter having a very similar structure to that of Berger '306) discloses that material for flavoring smoke can be added to the cavity created by the inner element of filter material (See col. 2, lines 54-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the

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invention to have incorporated a flavoring material into the cavity of Berger '306 since both filters are designed similarly and for the same purpose. Further, Dock discloses heat-activated capsules, appearing to be the claimed sizes, that rupture upon exposure to heat and are designed to be disposed within cigarette filters to deliver flavorants to the user during the smoking of the cigarette (see cols. 1 and 2, and Fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated one or more of these capsules into the cavity of the filter of the combined Berger references in order to receive the benefit of heat-activated capsules for imparting much-desired flavor, i.e. menthol, to cigarette smoke.

#### ***Allowable Subject Matter***

4. Claims 6, 13, 18, 27-28, 33, 35, 37, 40, 47, and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Berger '063 (US. Pat. No. 4,046,063)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne Walls Mayes  
Primary Examiner  
Art Unit 1731

October 20, 2005